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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

HO, R

ART UNIT

PAPER NUMBER

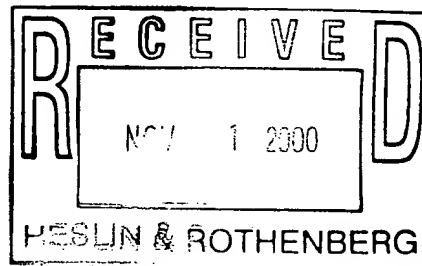
2172

DATE MAILED: 10/30/00

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Commissioner of Patents and Trademarks

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DOCKETED 4/30/01

# Office Action Summary

Application No.  
09/286,043

Applicant(s)

Schnelter et al.

Examiner

RUAY LIAN HO

Group Art Unit

2172



☒ Responsive to communication(s) filed on Sep 25, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-48 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2172

## ***Response to Amendment***

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-48 are rejected under 35 U.S.C. 102(a) as being anticipated by Hogan et al. (USPN 5,778,368).

#### **Regarding claim 1:**

Each and every element of claim 1 is disclosed by Hogan et al., note: the claimed 'requesting from a first computer to second computer remote from the first computer in the distributed computer system to search information of at least one entity' is shown in col.9, l.14-36,

the claimed 'indicating from the first computer to search agent associated with the second computer to at least one search criterion for the information of the at least one entity' is shown in col.14, l.25-33,

the claimed 'accessing by the search agent at least one database remote from the first computer and the second computer in the distributed computer system' is shown in col.9, l.14-36,

Art Unit: 2172

the claimed 'at least one database comprises information of a plurality of entities including the at least one entity, and wherein the at least one entity comprises less than all of the plurality of entities' is shown in col.11, l.37-61,

the claimed 'performing by the search agent a search based on the at least one search criterion on only the information of the at least one entity in the at least one database' is shown in col.11, l.37-61 & col.14, l.25-33.

**Regarding claim 2:**

The claimed 'providing results of the search to the search agent' is shown in col.11, l.37-61.

**Regarding claim 3:**

Claim 3 is rejected for the similar rationale given for claim 2.

**Regarding claim 4:**

The claimed 'the search agent is transferred from the second computer to the first computer and runs at the first computer, wherein a communication agent also resides at the first computer, the communication agent performing the requesting and the indicating, and wherein the search agent provides the results of the search to the communication agent' is shown in col.4, l.10-65.

**Regarding claim 5:**

The claimed 'at least one database is stored at least one third computer remote from the

Art Unit: 2172

first computer and the second computer in the distributed computer system, and wherein the search agent resides at the at least one third computer' is shown in col.11, l.1-13.

**Regarding claim 6:**

Claim 6 is rejected for the similar rationale given for claim 5.

**Regarding claim 7:**

Claim 7 is rejected for the similar rationale given for claim 5.

**Regarding claim 8:**

The claimed 'the first computer is associated with a buyer, wherein the second computer is associated with a seller, wherein the at least one entity comprises the seller, and wherein the information comprises product and/or service information of the seller' is shown in col.5, l.58 to col.6, l.26.

**Regarding claim 9:**

Claim 9 is rejected for the similar rationale given for claim 5.

**Regarding claim 10:**

Claim 10 is rejected for the similar rationale given for claim 1.

**Regarding claim 11:**

Claim 11 is rejected for the similar rationale given for claim 1.

**Regarding claim 12:**

Claim 12 is rejected for the similar rationale given for claims 1, 4, 8.

**Regarding claim 13:**

Art Unit: 2172

Claim 13 is rejected for the similar rationale given for claim 5.

**Regarding claim 14:**

Claim 14 is rejected for the similar rationale given for claim 5.

**Regarding claim 15:**

Claim 15 is rejected for the similar rationale given for claim 5.

**Regarding claim 16:**

The claimed 'at least one search criterion comprises a null criterion such that the search returns all information of the at least one entity in the at least one database' is shown in col.4, l.20-34.

**Regarding claims 17-33:**

Claims 17-33 are rejected for the similar rationale given for claims 1-16.

**Regarding claims 34-46:**

Claims 34-46 are rejected for the similar rationale given for claims 1-16.

**Regarding claim 47:**

Claim 47 is rejected for the similar rationale given for claim 1.

**Regarding claim 48:**

Claim 48 is rejected for the similar rationale given for claim 1.

3. Applicant's arguments filed with the 25 September 2000 amendment have been fully considered but they are not persuasive.

Art Unit: 2172

Applicants argued that 'claim 1 does not recite to search *for* information of the at least one entity, rather, it recites to search information of the at least one entity' is not persuasive because the Hogan patent clearly discloses the recited limitations in column 9, line 26, 'Web Page', and in column 5, line 7, 'Internet', every skilled in the art knows that end users may 'search for information' and 'search information of one entity' on the Internet. The limitations recited in claim 1 are fully disclosed by Hogan patent.

With regard to claim 4, Applicants argued that 'the repository server does the searching, and provides no disclosure regarding, for example, a search agent transferred from the repository server to a repository client' (page 4, lines 7-9) is not correct. The recited limitation in claim 4, 'the search agent is transferred from the second computer to the first computer and runs at the first computer', is fully disclosed by Hogan patent in column 9, lines 14-36. A search via Internet definitely involves 'the first computer' and 'the second computer', besides a search cannot be conducted without a search engine and the search results cannot be transferred without a communication agent, therefore, to any skilled in the art, both 'search agent' and 'communication agent' are well disclosed in the Hogan patent.

Regarding claim 5, Applicants argued that 'no disclosure in this section regarding location of a database, other than it being housed in the repository server' is not correct. A mailing list is a database, a web page is a database, and Internet itself can also be considered as a database, 'database' is a broad term used by the information industry, certainly, data in a repository is a database, and rebuttal of the 'third computer' has been given above.

Art Unit: 2172

With regard to claim 8, the location of a computer and the nature of information do not entitle any patentable weight.

Applicants still argued about 'format' and 'compatibility for a consistent Web site experience' limitations of claim 12 are not met and therefore no *prima facie* anticipation rejection. It is common knowledge to one with ordinary skill in the art that access Web sites with any particular format (such as AOL, Yahoo!) can provide search results with 'compatibility for a consistent Web site experience.'

With respect to the 'null criterion' limitation in claim 16, the common interpretation of 'null criterion' is 'invalid criterion' or 'insignificant criterion', and it is suggested by Hogan patent as a software characterization unless there is a special character of 'null criterion' claimed and, of course, supported by the specification of record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



Art Unit: 2172

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruay L. Ho whose telephone number is (703) 305-3834. The examiner can normally be reached on Monday - Friday from 10 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Yen Vu, can be reached on (703) 305-4393. The fax phone number for this Group is (703) 308-9051 or (703) 308-5403.

- Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

  
RUAY LIAN HO  
PRIMARY EXAMINER



UNITED STATES DEPARTMENT OF COMMERCE  
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## Attention: Policy on Returning Phone Calls

A PTO-wide customer service standard is if a PTO employee being called is not available they will return your call by the next business day, or, if you request, an alternate point of contact will be provided. Technology Center 2700 is committed to meeting this service standard. If you have called any employee in our Technology Center and have not received a return phone call within one (1) business day or have not been provided another point of contact, please contact the Technology Center at 703-306-5631. We ensure that you will receive a return phone call, from an employee with the ability to assist you, within four (4) business hours of this contact. We appreciate your help in assisting us to help you.

The employees of Technology Center 2700